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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78246819
Applicant	Paul Stuart, Inc.
Applied for Mark	SILKY POWDER
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of:	Paul Stuart, Inc.
Serial No.:	78/246,819
Filed:	May 7, 2003
Mark:	**SILKY POWDER**

Commissioner for Trademarks
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BRIEF ON APPEAL

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I. INTRODUCTION

Disregarding the fact that there are multiple registrations for the same or related goods that contain the term POWDER (*e.g.*, POWDER ROOM, POWDER BLU, GOT POWDER?, etc.), and totally ignoring the term SILKY in Applicant's composite mark SILKY POWDER, the Examining Attorney has finally rejected Applicant's mark over the reference for the mark POWDER & DESIGN - a Registration that issued notwithstanding the registration of the other aforementioned "POWDER" marks. At best, Applicant's mark SILKY POWDER and the cited reference for POWDER & DESIGN share a common term POWDER, as do the other preexisting Registrations. However, that is where the similarity (if any) ends. The term POWDER, of the reference, is only entitled to a narrow scope of protection. Applicant's mark differs visually, aurally, in meaning and conjures up a different picture.

Accordingly, it is submitted there that is no likelihood of confusion, that the Examiner's decision should be reversed, and that the application should be allowed.

II. PROCEDURAL HISTORY

Applicant seeks to register the mark SILKY POWDER for "clothing, namely suits, pants, shirts and jackets," in Class 25.

In a first Office Action, issued on October 18, 2003, the Examining Attorney notified Applicant of a then prior pending application for POWDER & Design (now Reg. No. 2,843,001, hereinafter the "001 mark") for underwear, sleepwear, socks, blouses, dresses, skirts, jackets, jeans, swimwear, sweatshirts and hats. The Examining Attorney advised that a refusal could issue if the '001 mark application matured into a

Registration. In addition, Applicant was required to amend the identification of goods and disclaim the word SILKY apart from the applied-for mark.

In response to the Office Action, on April 13, 2004, Applicant submitted arguments against the citation to the '001 mark, calling attention to (1) the differences in sight, sound, and meaning between the marks, and (2) the existence of multiple third-party registrations of POWDER-formative marks for clothing. Applicant amended the identification of goods and disclaimed the word "SILKY" apart from the applied-for mark.

On May 16, 2004, the Examining Attorney issued a Notice of Suspension pending the disposition of the pending application for POWDER & Design. The Examining Attorney accepted Applicant's amended identification of goods and disclaimer of the word SILKY, but upheld the rejection over the '001 mark.

The '001 mark was registered on May 18, 2004. On February 24, 2005, the Examining Attorney issued a refusal to register Applicant's mark alleging likelihood of confusion under Section 2(d) of the Trademark Act, rejecting Applicant's arguments against likelihood of confusion. The Examining Attorney placed little weight on the existence of multiple third-party registrations for POWDER-formative marks in connection with clothing products and the fact that Applicant's mark was a composite mark.

On April 21, 2005, Applicant filed a response citing additional T.T.A.B. and C.C.P.A. decisions in support of its arguments against the Section 2(d) refusal and in support of its position that the cited mark is entitled to a narrow scope of protection.

On June 2, 2005, the Examining Attorney issued a final refusal to register Applicant's mark based on likelihood of confusion.

On November 17, 2005, Applicant filed the subject Appeal as well as a Request for Reconsideration. In the Request for Reconsideration, Applicant (1) further argued the narrow scope of protection that the '001 mark should receive, given the numerous third-party registrations for "POWDER"-formative marks on clothing products; (2) argued that a likelihood of confusion could not exist between Applicant's mark and the '001 mark, where the '001 mark was allowed over the numerous prior-registered marks containing POWDER, and where the record shows that the registrant of the '001 mark did not assert any likelihood of confusion objections against other POWDER marks; and, (3) argued that the Trademark Office has already established a track record in support of the position that there is no likelihood of confusion among POWDER marks based on the presence of several two-word marks of record containing POWDER and the '001 mark and, thus, should not be able to accord broader protection to the later-filed mark POWDER & Design than to the earlier marks.

On December 5, 2005, the Examining Attorney issued a denial of Applicant's Request for Reconsideration without further comment.

III. STATEMENT OF CASE

Section 2(d) of the Trademark Act states that,

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused...unless it [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office...as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

It is Applicant's position that registration of the mark SILKY POWDER will not cause confusion with the mark POWDER & Design cited by the Examining Attorney because:

a) Applicant's mark differs in sight, sound, meaning and commercial impression from the mark cited by the Examining Attorney; and

b) the mark cited by the Examining Attorney is, by the Examining Attorney's own analysis, the dominant part of other registration and is entitled to a narrow scope of protection.

As likelihood of confusion is assessed on a case-by-case basis, by application of an inexhaustive list of factors, Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Section 2(d) refusal. *See In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

IV. LIKELIHOOD OF CONFUSION

In *ex parte* examinations, a likelihood of confusion under § 2(d) will be found if customers are likely to assume erroneously the existence of an association or connection between the applicant's goods or services and the prior registered mark. *In re Phillips-Van Heusen Corp.*, 228 U.S.P.Q. 949 (T.T.A.B. 1986); *Bongrain Int'l (American) Corp. v. Moquet, Ltd.*, 230 U.S.P.Q. 626 (T.T.A.B. 1986).

Likelihood of confusion may not be found where consumer confusion is only possible. Rather, likelihood of confusion exists where consumer confusion is "probable." *Rodeo Collection Ltd. v. West Seventh*, 812 F.2d 1215, 1217, 2 U.S.P.Q. 2d 1204, 1206 (9th Cir. 1987). The proper standard for assessing likelihood of confusion is whether the

ordinary, reasonably prudent purchaser in the marketplace would likely be confused. Whether a judge, jury or Examining Attorney would be personally confused is irrelevant. Thus, it is appropriate for the Board to place itself in the shoes of the prospective purchaser. *E.I. Du Pont de Nemours & Co. v. Yoshida Int'l, Inc*, 393 F. Supp. 502, 510, 185 U.S.P.Q. 597, 603 (E.D.N.Y. 1975).

A. APPLICANT'S MARK DIFFERS FROM THE CITED MARK IN SIGHT, SOUND AND MEANING

An adjudicating body must consider marks in their entireties, not in their dissected parts, when determining whether a likelihood of confusion exists. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985). "[T]he overall commercial impression derived from viewing marks in their entireties is of *paramount interest* in determining whether confusing similarity exists." *Wagner Elec. Corp. v. Raygo Wagner, Inc.*, 192 U.S.P.Q. 33, 43 (T.T.A.B. 1976) citing *New England Fish Co. v. The Hervin Co.*, 184 U.S.P.Q. 817 (C.C.P.A. 1975) (emphasis added); *see also In re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (noting that marks are perceived in their entireties and, therefore, all components thereof must be given appropriate weight). This anti-dissection rule applies even when a mark consists in part of a term which is descriptive or has been disclaimed. "Arguments to the effect that one portion of a mark possesses no trademark significance leading to direct comparison between what remains is an erroneous approach." *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 1295, 184 U.S.P.Q. 35, 37 (C.C.P.A. 1974) (SPICE TREE and tree design held not to be confusingly similar to SPICE ISLAND and tree design, both for spices). Any conclusions that the marks are similar with respect to any element of the sight, sound, or meaning triology does not automatically result in a likelihood of

confusion, even if the goods are closely related. Rather, the adjudicating body must take into account all relevant facts of a particular case. *See In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (T.T.A.B. 1987). "[E]ach case requires consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark." *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 U.S.P.Q. at 43 quoting *Rockwood Chocolate Co., Inc. v. Hoffman Candy Co.*, 152 U.S.P.Q. 599 (C.C.P.A. 1967).

The Examining Attorney argues, in the Office Action mailed February 24, 2005, that a feature of a mark may be recognized as more significant in creating a commercial impression and then focuses on the "...same dominant wording, 'POWDER'." However, since SILKY does modify POWDER, it is that precise reason why the public will not focus on the term POWDER alone. The mark will be interpreted as what it is - a composite mark with each term being given the same weight. The connotation is that the "POWDER" is smooth and the SILKY element of the mark cannot be disregarded.

In fact, the Examining Attorney's own analysis is inconsistent. In attempting to distinguish over third party registrations cited by Applicant to show the weakness of POWDER, the Examining Attorney considered the registrations in their entirety, contrary to the position taken above. Thus:

> Notwithstanding the foregoing, Registration Nos. 2,497,557 (for POWDER ROOM); 2,390,622 (for POWDER BLU); 2,267,688 (POWDER RIVER); and 1,512,825 (POWDER BANDIT), while all contain the word "POWDER," each creates a different commercial impression than the word "POWDER" standing alone. For instance, "POWDER ROOM" is another name for a women's restroom; and "POWDER BLUE," the phonetic equivalent of "POWDER BLU," is a "moderate to pale blue or purplish blue" color.

The Examining Attorney is correct that "...each [third party Registration] creates a different commercial impression than the word "POWDER" standing alone." However, by the same analysis SILKY POWDER also creates a different commercial impression than POWDER alone, certainly as much as *e.g.*, POWDER BLU. When Applicant's composite mark is considered in its entirety, it is clearly distinguishable from the reference.

Applicant's two-word mark SILKY POWDER is visually different from the '001 mark POWDER & Design. The '001 mark is in a linked, stylized format on a design of small dots coming together to form a black diamond, thus creating a specific commercial effect. Applicant's mark contains the additional term "SILKY" and contains no design element – an altogether different overall effect from the '001 mark. These two marks do not only differ by the presence of an additional word, they also differ in stylization and design. These differences dramatically distinguish the subject marks. Design elements of a mark can substantially differentiate it from a stand-alone mark. *See, e.g., In re The Ridge Tahoe*, 221 U.S.P.Q. 839 (T.T.A.B. 1983) (holding that the commercial impression of the design mark, THE RIDGE TAHOE, was "substantially different" in commercial impression from the word mark, RIDGE); *see also Wagner Electric Corp.*, 192 U.S.P.Q. at 43 (finding RAYGO WAGNER and Design, with a design of a man on a platform distinguishable from the word mark WAGNER alone). While Applicant agrees that its mark is a word mark in block form and the font can be in any form, the cited mark is a specific design that would not be encompassed by Applicant's word mark. Thus, the cited reference (Exhibit "A") shows the mark in script form with a diamond shaped background having a central black core and dotted elements forming the outer diamond

design. The script "powder" is centrally positioned on the diamond with the "p" and the "r" falling outside the diamond. Thus, visually the cited reference is critically different from Applicant's mark. The cited reference is a unique design. It is an oversimplification to state that greater weight should be given to the literal portion and to ignore the design/script elements.

Furthermore, the marks also differ in sound, yet another factor that weighs against a likelihood of confusion. The cited mark, POWDER, is pronounced with two syllables. In contrast, Applicant's mark, SILKY POWDER, is pronounced as four syllables. This Board has held that different mark pronunciations and/or different numbers of syllables that comprise a mark diminish a likelihood of confusion. *See in re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (finding VARGA GIRL for calendars does not look or sound similar to VARGAS for calendars, posters, and similar goods); *see also J. Wiss & Sons Co. v. Gee Whiz Tool Corp.*, 364 F.2d 910, 911, 150 U.S.P.Q. 583, 584 (6th Cir. 1966) (finding no likelihood of confusion between WIZZ and GEE WHIZ for pruning shears); *see also Knapp-Monarch Co. v. Poloron Prods., Inc.*, 134 U.S.P.Q. 412, 414 (T.T.A.B. 1962) (finding THERMEX for insulated food and beverage containers does not look or sound like THERM-A-JUG for insulated beverage containers). While the marks at issue differ by one word, even marks that differ by only *one letter* have been found not to be phonetically similar. *See In re Reach Electronics, Inc.*, 175 U.S.P.Q. 734, 735 (T.T.A.B. 1972) (finding no likelihood of confusion between REAC and REACH for power supplies).

Third as noted above, the marks differ in meaning. Despite the disclaimer, SILKY is an important modifier of the word POWDER that cannot be ignored. When

one imagines the feel of POWDER, the notion of SILKY suggests a smoothness or softness not present when encountering the word POWDER alone.

B. THE COEXISTENCE OF SIMILAR MARKS DICTATES AGAINST A FINDING OF CONFUSION

In addition to comparing the respective marks, it is appropriate to analyze the number of similar marks in use on similar goods. *In re E.I. DuPont DeNemours,* 177 U.S.P.Q. at 567 (C.C.P.A. 1973). Contrary to the Examining Attorney's argument that "...third-party registrations by themselves are entitled to little weight on the question of likelihood of confusion", it is submitted that third party registrations of similar marks for identical or closely related goods are probative evidence that the marks are not particularly distinctive in the field. *See Western Publ'g Co., Inc. v. Rose Art Indus., Inc.*, 910 F.2d 57, 61 (2d Cir. 1990) (noting that multiple third party registrations of marks similar to plaintiff's mark, for use on similar goods, undercut the origin-designating function of plaintiff's mark). Such coexisting marks demonstrate that consumers are accustomed to looking to the other elements of the mark in order to distinguish the source of goods or services in the relevant field. *In re Broadway Chicken, Inc.,* 38 U.S.P.Q. 2d 155 (T.T.A.B. 1996) (BROADWAY CHICKEN registrable over BROADWAY PIZZA, both for restaurant services, where evidence showed frequent use of BROADWAY in marks for restaurant and eating establishments). Thus, such multiple-registered marks possess a lesser origin-indicating quality and deserve a narrow scope of protection. *Id.; see also Ivoclar North America, Inc. v. Dentsply Int'l, Inc.*, 41 F. Supp. 2d 274 (S.D.N.Y. 1998). Therefore, the ordinary reasonably prudent purchaser in the marketplace is unlikely to be confused between Applicant's mark SILKY POWDER and the '001 mark POWDER & Design.

The cited mark POWDER & Design coexists with at least five "Powder"-formative marks, used in connection with clothing products, all registered before the present reference. The marks were made of record in Applicant's response dated April 13, 2004 and are reproduced below[1]:

TRADEMARK	REG. NO./ FILING DATE	GOODS/SERVICES (CLASS)
GOT POWDER?	2,759,084 11/09/02	Shirts, jackets, pants, and hats (25)
POWDER ROOM	2,497,557 6/28/99	Sunglasses (9); watches (14); all purpose athletic bags (18); clothing and outerwear, namely, jackets, pants, skirts, dresses, swimsuits, shorts, shirts, sweatshirts, sport shirts, sweaters, socks, hats, caps, visors, gloves, mitts, shoes, boots, belts, footwear, headwear (25)
POWDER BLU	2,390,622 6/21/99	Clothing for men and women, namely, women's sweatsuits, sweatshirts and footwear, knits and women tops, bottoms, dresses, skirts, pants and shorts and men's sportswear, namely, pants, shirts, sweaters and shorts (25)
POWDER RIVER	2,267,688 9/18/97	Clothing, namely, shirts, blouses, dresses, skirts, shorts, jeans, pants, jackets, coats, hats, gloves, socks, scarves, belts, shoes, and boots for men, women, and children (25)
POWDER BANDIT	1,512,825 4/4/88	Clothing, namely skiwear and insulated scarves (25)

The existence of these similar trademark registrations demonstrates that the Trademark Office has ascertained an improbable likelihood of consumer confusion among these marks for clothing products. These several third-party registrations for POWDER-formative marks on clothing products are evidence of the weak origin-designating

[1] The allowed application for FLOO POWDER (Ser. No. 78/065,017) included in Applicant's prior response was marked abandoned on May 12, 2005 due to failure to file a statement of use.

function of "powder" for clothing products and entitle marks containing POWDER, including the cited mark POWDER & Design, to only a narrow scope of protection. *In re Broadway Chicken*, 38 U.S.P.Q. 2d at 1566, *see also Fortunoff Silver Sales Inc. v. Norman Press Inc.*, 225 U.S.P.Q. 863, 869 (T.T.A.B. 1985). Given the narrow protection to be accorded POWDER marks, Applicant submits that no likelihood of confusion exists between its mark SILKY POWDER and the cited '001 mark POWDER & Design, and that Applicant's mark should be allowed.

Moreover, where the '001 mark was allowed over these five prior marks, all of which were filed earlier than the '001 mark, there is no basis for the Examining Attorney to conclude that the registration for the '001 mark can block Applicant's distinguishable mark from registration.

In addition, the evidence of record suggests that the registrant of the '001 mark is not concerned about likelihood of confusion among POWDER marks. The registrant claims a date of first use in commerce of August 1, 1999. This is earlier than the first use date of the GOT POWDER? registration (October 9, 2002), yet the registrant of the '001 mark did not oppose the GOT POWDER? application. Where the registrant and the other owners of POWDER marks have accepted the coexistence of others in this crowded field, Applicant's mark should be entitled to registration as well.

V. CONCLUSION

The arguments set forth herein have conclusively demonstrated that registration of Applicant's mark SILKY POWDER for the goods specified in the application will not cause confusion, mistake or deception with the registered mark POWDER & Design. For

the foregoing reasons, it is respectfully requested that the refusal to register be withdrawn, and Applicant's mark passed to publication.

Respectfully submitted,

Date: May 30, 2006

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EXHIBIT A